

REMARKS

In this Amendment, claim 12 has been canceled, without prejudice or disclaimer of the subject matter thereof, and claim 8 has been amended to more appropriately define Applicant's invention.

In the Final Office Action dated April 7, 2003, the Examiner rejected claims 8-9 and 11 under 35 U.S.C. § 103(a) as unpatentable over Kelly et al. (U.S. Patent No. 6,010,074) in view of Yap et al. (U.S. Patent No. 6,111,506), and further in view of Rostoker et al. (U.S. Patent No. 6,373,447), and rejected claim 12 under 35 U.S.C. § 103(a) as unpatentable over Kelly et al., in view of Yap et al. and Rostoker et al., and further in view of Farmont (U.S. Patent No. 5,498,859).

In view of the following remarks, Applicant respectfully traverses the Examiner's rejections of the claims under 35 U.S.C. § 103(a).

The Examiner rejected claims 8-9 and 11 under 35 U.S.C. § 103(a) as unpatentable over Kelly et al., in view of Yap et al., and further in view of Rostoker et al.. This rejection is respectfully traversed because a prima facie case of obviousness has not been made by the Examiner. To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference as modified must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. 2143.03 (8th ed. 2001)).

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Present claim 8 provides for a wireless information storage device, comprising: a coil antenna having a two-dimensional center for transmitting and/or receiving a signal via wireless communication and a space therein; a memory arranged in the space of the coil antenna for storing information; a control unit that generates information by demodulating a signal received via the coil antenna, and generates a signal to be transmitted via the coil antenna by modulating information stored in the memory, the control unit being arranged in the space of the coil antenna; and a molded case having a two-dimensional center including the coil antenna, wherein each coil antenna is located at a position in the device relatively different from each other when a plurality of devices is stacked.

Applicant respectfully submits that Kelly et al., in view of Yap et al., and further in view of Rostoker et al. do not disclose or suggest at least this claimed combination of elements. For example, the references do not disclose or suggest at least a molded case having a two-dimensional center including the coil antenna, wherein each coil antenna is located at a position in the device relatively different from each other when a plurality of devices is stacked.

In the Final Office Action dated April 7, 2003, the Examiner again admitted that neither Kelly et al. nor Yap et al. teach a device in which each coil antenna is located at a position in the device relatively different from each other when a plurality of devices is stacked. In recognizing the shortcomings of these two references, the Examiner is correct. Accordingly, Yap et al., either alone or in combination with Kelly et al., do not disclose, teach, or suggest at least a molded case having a two-dimensional center

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

including the coil antenna, wherein each coil antenna is located at a position in the device relatively different from each other when a plurality of devices is stacked.

The Examiner also explained that the Rostoker et al. reference was introduced to overcome the deficiencies of Kelly et al. and Yap et al. Rostoker et al., however, are not sufficient to overcome the aforementioned deficiencies of Kelly et al. and Yap et al. Rostoker et al. disclose a system in which an IC chip may include multiple antennas (col. 8, line 66 - col. 9, line 12). For example, a first antenna may be disposed within one portion of the IC chip, and a second antenna may be disposed within another portion of the IC chip (col. 9, lines 12-18). This embodiment of Rostoker et al., however, does not disclose that the antennas are located at a position in the IC chip relatively different from each other when a plurality of IC chips is stacked as claimed. This embodiment shows antennas within one device. The various chip portions disclosed by Rostoker et al. are not on different levels.

Another embodiment disclosed by Rostoker et al. shows that multiple antennas may be disposed in two different vertical planes on a single IC chip (col. 10, lines 9-15; FIGS. 7A and 7B). These antennas, however, are concentric with each other (FIGS. 7A and 7B; col. 10, lines 36-46). As such, this embodiment of Rostoker et al. does not disclose that the antennas are located at a position in a device relatively different from each other when a plurality devices is stacked as claimed.

In the Final Office Action dated April 7, 2003, the Examiner argued that Rostoker et al. show antennas disposed in different portions at column 9, lines 19-35 and in Figure 6 (Office Action, page 3). The Examiner also alleged that Rostoker et al. provide evidence that the different portion could be different layers at column 10, lines 1-46 and

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

in Figures 7 and 8. The Examiner, however, seems to ignore that one embodiment shows that antennas can be disposed in different portions, and a completely separate embodiment shows that two antennas can be disposed in different vertical planes. Figures 7A and 7B of the Rostoker et al. reference are drawn to the aforementioned separate embodiment and demonstrate that the antennas are concentric with each other (see also, Rostoker et al., col. 10, lines 9-59). There is no suggestion or motivation in any of the references to position the stacked antennas so that they are not concentric with each other. The Examiner points to the concept of disposing antennas in different portions but does not provide a motivation as to why one of ordinary skill in the art would take this concept and apply it to the aforementioned separate embodiment of Rostoker et al. No combination of the references suggests positioning stacked antennas so that they are not concentric with each other.

Accordingly, Rostoker et al., taken either alone or in combination with Kelly et al. and Yap et al., do not disclose, teach, or suggest at least a molded case having a two-dimensional center including the coil antenna, wherein each coil antenna is located at a position in the device relatively different from each other when a plurality of devices is stacked.

For at least the foregoing reasons, Applicant submits that claim 8 is patentable over Kelly et al. in view of Yap et al., and further in view of Rostoker et al. Because claim 11 is an independent claim with recitations similar to those of claim 8, Applicant further submits that claim 11 is patentable over Kelly et al. in view of Yap et al., and further in view of Rostoker et al. for at least the reasons given with respect to claim 8.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

300 I Street, NW
Washington, DC 20005
202.408.4000
fax 202.408.4400
www.finnegan.com

Dependent claim 9 is allowable not only for the reasons stated above with regard to its respective allowable base claim, but also for its own patentable features that distinguish them from Kelly et al., Yap et al., and Rostoker et al.

The Examiner rejected claim 12 under 35 U.S.C. § 103(a) as unpatentable over Kelly et al. in view of Yap et al. and Rostoker et al., and further in view of Farnmont. Applicant has canceled claim 12, rendering this ground of rejection moot.

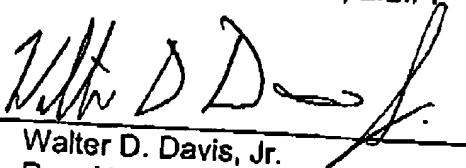
Since each of the claims is allowable, Applicant respectfully requests the timely allowance of this application.

If an extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Amendment, such extension is requested. If there are any other fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 7, 2003

By: 
Walter D. Davis, Jr.
Reg. No. 45,137

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

11 Street, NW
Washington, DC 20005
202.408.4000
202.408.4400
finnegan.com